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Applicant	:	Scott C. Harris	Group Art Unit: 3693
Appl. No.	:	10/064,439	Confirmation: 2498
Filed	:	July 14, 2002	
For	:	Web Based Communication of Information With Reconfigurable Format	
Examiner	:	H. Fu	

AMENDMENT (After Final Rejection)

Commissioner For Patents
Box AF
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Official Action dated March 25, 2010, kindly amend

the above referenced application as follows:

Amendments to the claims begin on page 2 of this paper.

Applicant Remarks begin on page 16 of this paper.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. (Canceled)

2. (Previously Presented) A system as in claim 8, wherein said e-mail messages include e-mail messages in plain text form.

3. (Previously Presented) A system as in claim 8, further comprising an e-mail pager, producing said e-mail messages.

4. (Previously Presented) A system as in claim 8, further comprising a cellular telephone, producing said e-mail messages.

5. (Previously Presented) A system as in claim 8, wherein said information determining part receives and translates a user ID and password as part of said email messages.

6. (Previously Presented) A system as in claim 8, wherein said information determining part automatically recognizes phrases that include the word "bid" in said email as one of said words and where said action is a bid on one said items for sale over the Internet.

7. (Previously Presented) A system as in claim 8, wherein said information determining part also sends e-mail messages indicative of information about said auctions.

8. (Currently Amended) A system, comprising:

a web server, producing a web page which is available on the Internet wherein said web server is a server with a processor that is programmed to host ~~hosts~~ auctions of items for sale and maintains auction bids for items for sale over the Internet; and

an information determining part associated with said web server which receives e-mail messages and obtains information from said e-mail messages, said information being in a form which can interact with said web page being produced by said web server;

wherein said information determining part having a keyword recognition system which recognizes at least one word in at least one of the email messages to

determine automatically a desired action of said email without requiring a special form for the email to recognize said at least one word,

and wherein said information determining part also sends e-mail messages that include information about items in said auctions for sale over the Internet, on which items a user has been outbid.

9. (Currently Amended) A system as in claim 8, wherein said information determining part produces and sends messages which include a session identification indicator that identifies ~~said~~ auction information, and that where said session identification indicator is a unique value, that unambiguously represents an item in said auction information.

10. (Previously Presented) A system as in claim 9, wherein said information determining part detects a reply to a plain text message which reply including said session identification indicator, and takes action on a specified auction based on said session identification indicator.

11. (Previously Presented) A system as in claim 8, wherein said information determining part also sends e-mail messages indicative of actions occurring on said web page.

12. (Previously Presented) A system as in claim 11, wherein said e-mail messages include a session ID indicative of said actions where said session ID is a unique value, that unambiguously represents an item to be bid on.

13. (Previously Presented) A system as in claim 12, wherein said session ID is included as part of a return address in the e-mail message.

14. (Previously Presented) A system as in claim 13, wherein the session ID is used to interact with said actions on said Web page.

15. (Previously Presented) A system as in claim 10, wherein said action includes placing a new bid.

16. (Previously Presented) A system as in claim 8, wherein said keyword recognition system in said information determining part automatically detects a new bid amount as part of a sent message.

17. (Canceled)

18. (Previously Presented) A method as in claim 22, further comprising sending a second e-mail that has instructions on a specific interaction with said web page.

19. (Previously Presented) A method as in claim 22, wherein said first e-mail includes information that requests specified information from said web page, and further comprising sending a response including said specified information.

20. (Canceled)

21. (Canceled)

22. (Currently Amended) A method, comprising:

producing a web page on a server which includes a processor that is connected to the Internet wherein said web page is a web page for a server that hosts Internet based auctions; and

receiving a first e-mail message on the server, which e-mail has instructions to interact with said web page;

on the server, using a keyword recognition system running on said processor to automatically recognize at least one word in the first email message, to determine

automatically a desired action of said email without requiring a special form for the first email message to recognize said at least one word,

wherein said at least one word comprises a word that instructs bid on an item on an Internet based auction; and

wherein said item is an item on which a user has been previously outbid.

23. (Previously Presented) A method as in claim 22, wherein said web page is an e-commerce site.

24. (Previously Presented) A method as in claim 22, wherein said web page is a web page for a server that hosts Internet based auctions.

25. (Previously Presented) A method as in claim 24, wherein said e-mail message includes a session ID indicative of an individual auction on said web page, where said session ID is a unique value, that unambiguously represents one of said individual auctions.

26. (Previously Presented) A method as in claim 22, wherein said keyword recognition system automatically recognizes phrases that include the word "bid" in said email as one of said words.

27. (Previously Presented) A method as in claim 26, further comprising replying to said first e-mail message with instructions to increase a bid.

28. (Currently Amended) A method as in claim 18, wherein said e-mail message includes session ID information that represents ~~said~~ an individual auction on which said user has been previously outbid, where said session ID is a unique value, that unambiguously represents one of said individual auctions.

29. (Previously Presented) A method as in claim 28, further comprising replying to said e-mail message with said session ID information, and modifying a bid on said web page responsive to said replying.

30. (Previously Presented) A method as in claim 29, wherein said session ID is part of a return address for said e-mail.

31. (Previously Presented) A method as in claim 29, wherein said replying includes specifying an amount of a bid to be placed.

32. (Previously Presented) A method as in claim 22, wherein said e-mail message includes a session ID indicative of an individual item on said web page, and where said session ID is a unique value, that unambiguously represents said individual item.

33-64. (Canceled)

65. (Currently Amended) A system, comprising:

a web server, producing a web page which is available on the Internet, wherein said web server includes a processor which is programmed for producing produces a web page that hosts auctions of items for sale and maintains auction bids for items for sale over the Internet; and

an information determining part associated with said web server which receives e-mail messages and automatically determines information from said e-mail messages in a form which can interact with said auctions on said web page being produced by said web server;

wherein said information determining part having a keyword recognition system which recognizes at least phrases that include the word "bid" in an email message to determine automatically that a bid action is being requested by said email, and automatically provides information about said bid action to said web server,

wherein said web server also accepts a bid based on said information about said bid action.

66. (Currently Amended) A system as in claim 65, wherein said information determining part and sends messages which include a session identification indicator that identifies ~~said~~ auction information, and that where said session identification indicator is a unique value, that unambiguously represents an item in said auction information.

67. (Previously Presented) A system as in claim 66, wherein said session identification indicator is included as part of a return address in the e-mail message.

68. (Previously Presented) A system as in claim 66, wherein said session identification indicator is included as alphanumeric information in the email.

69. (Previously Presented) A system as in claim 66, wherein the session identification indicator is used to interact with said actions on said Web page.

Remarks

Reconsideration and allowance of the above referenced application are respectfully requested.

Claims 2-16 and 65-69 stands rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement.

This contention is respectfully traversed.

The rejection queries where the "information determining part" is shown in the specification. The original specification referred to a module 115 in figure 1, and pages 3-4 of the specification explains this "can be a conventional Web service or other subscription service, or simply can be an interfacing program that is running on a computer...".

This was previously claimed as an information translating part, but applicants believed that an information determining part is actually more accurate, since this part determines information. The specific label of "information determining part" was not disclosed in the original specification; however its function was clearly disclosed as determining information. Therefore, this is clearly supported within the originally filed specification.

Figure 2 as originally filed explains the flowchart of operation, and it is quite clear from figure 2 that information is determined, for example element 210

looks up personal information and element 220 gets an existing list. Clearly this is determining information, and hence clearly this supports an "information determining part".

In addition, the information determining part in figure 2 is described as parsing the information in the e-mail; see element 225 in figure 2A and paragraphs 23-24 of the specification which explained that this obtains information from the e-mail message.

The disclosure described the information in a form that can interact with the webpages, see for example items 226, 227.

Turning to the specific claims, Claim 8 defines a keyword recognition system that recognizes at least one word in at least one of the e-mail messages, see paragraph 22 of the original specification that describes parsing words from the e-mail. Therefore, claim 8 is clearly wholly supported by the original specification.

To the extent that this rejection also applies to claim 22, claim 22 also uses a keyword recognition system to automatically recognize words in the e-mail message see paragraph 22 and element 225 in figure 2.

To the extent that this also applies to claim 65, Claim 65 defines the information determining part with a keyword recognition system again see paragraph 22 of the specification and element 25 in figure 2.

Therefore, the contention that these claims fail to comply with the written description requirement is respectfully traversed. According to the specification, applicants clearly had possession of this subject matter as of the filing date.

Claim 10 is rejected as reciting the limitation "said plain text messages". This rejection is not understood, since claim 10 was clearly amended in the July 20, 2009 amendment to recite that "said information determining part detects a reply to a plain text message". A screen shot from the actual amendment is reproduced below.

10.　　(Currently Amended)　　A system as in claim 9, wherein said information translatingdetermining part detects a reply to one of said a plain text messages message which reply including said session identification indicator, and takes action on a specified auction based on said session identification indicator.

Therefore, applicants believe that this issue was previously overcome.

Claims 18 and 22-32 stands rejected under 35 USC 101 as allegedly directed to non-statutory subject matter.

This contention is respectfully traversed. Claim 18 clearly defines that the webpage is produced on a server that is connected to the Internet, that an e-mail

message is received on the server, and that the server uses a keyword recognition system to recognize at least one word in the e-mail message. Hence, claim defines operations that are tied to a particular apparatus: here a server.

The statement in the office action that simply stating that a method is computer implemented in the preamble is not sufficient to tie to a statutory class is not understood, since this is not what is done here.

Moreover, the patent office's contention that a server could be a program rather than a computer is believed to be a difference without a distinction. Based on the structure of the claim, the "server" must be something that executes the steps. Whether you call this a program or a computer, it is still something that is executing the steps of the operation. As claimed, this cannot be software per se, because it defines the computer that is executing the operations.

However, in order to comply with the patent office's requests, each of the independent claims have been amended to clarify that the Web server includes a processor. It is respectfully suggested that this does not raise new issues after final, since this is based on the Examiner's specific suggestion on page 4, and it is believed that the examiner in any case interpreted the claims this way. Moreover, since this should obviate this issue raised by the office action, this amendment clearly places the application in better condition for appeal.

Some minor instances of indefiniteness have also been corrected, none of which should raise new issues after final.

Claims 2, 6-16, 18, 22-32, 65-67, and 69 stand rejected under 35 USC 103(a) as being unpatentable over Fisher et al. (US 5,835,896) in view of Powell (US 7,058,582).

This contention is respectfully traversed.

Fisher shows a generalized auction webpage. The rejection agrees, however, that Fisher does not show a keyword recognition system of the type claimed, that interfaces with an auction webpage.

Applicant does not concede that Powell is prior art.

This response assumes that Powell was prior art. Powell teaches a webpage modification system which allows a user to modify webpage contents through using e-mails.

Initially, it is respectfully suggested that the hypothetical combination of Fisher in view of Powell is not a proper legal combination of prior art.

The combination of Fisher in view of Powell is made based on the teaching of the present specification, not based on anything in the prior art. Fisher

specifically discusses sending the information in forms. The only teaching for sending information to a Web server that hosts auctions of items for sale comes from the present application, not from the prior art.

The secondary reference to Powell similarly does not teach receiving e-mails about information that can interact with the webpage that hosts auctions of items for sale and maintains auction bids for items for sale. In fact, the secondary reference to Powell teaches the user modifying <u>the webpage itself</u>,

A reference cannot be relied on for only one part of its teaching. A reference must be considered as a whole, see MPEP 2142.02VI, and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Therefore, the entire teaching of Powell must be considered. Here, Powell teaches operations to modify the webpage itself.

When a user bids on an Internet auction, that bid is based on items or other things shown on the webpage. That is, the bid is based on what the webpage shows. If you change the webpage, you change the subject of the bid. That is, the bid is no longer valid once the webpage is changed. As an example, if you bid on an auction for a motorcycle, and then change the webpage to show a bicycle, the previous bid on the motorcycle would no longer be valid.

Powell's teaching of changing the webpage is therefore wholly inconsistent with Fisher's teaching of bidding on Internet items. When you change the webpage as in Powell, you would change the subject of the bid. The bid would no longer be valid once the webpage was changed. Therefore, <u>Powell would destroy the functionality of bidding on an Internet item</u> through its teaching of changing the web page itself. Conversely, Fisher defines an environment where the webpage could not be changed since bids are being taken on that webpage. Fisher hence would destroy the functionality of Powell who requires changing the webpage.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as

well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Moreover, as a wholly separate reason for lack of combination, nothing in the prior art teaches the specific functionality of interacting with an Internet auction by using keyword recognition as claimed.

MPEP 2143 clearly explains that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the teaching to combine the references is not in either reference, but is rather in the present specification. Hindsight reconstruction occurs when one uses the current application "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the

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claims ...'" (quoting Orthopedic Equip. Co. v. United States, 702 F.2d 1005, 1012 (Fed. Cir. 1983))).

That is precisely what has been done here. Accordingly, the combination of Fisher in view of Powell is based on hindsight.

Moreover, the patent office has not met its duty of providing a reasoned basis why the references would or could be combined. Here, the rejection states that "one would have been motivated to combine the references in order to eliminate the need for specialized knowledge in the Web".

With all due respect, this is a conclusory statement and not applicable to either the claimed invention or to the references. This statement simply alleges that the results that are claimed in the current application would be desirable, without saying why it would have been obvious to combine the references. This is precisely contrary to what is required by MPEP 2143.01 (IV), which says "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR v Teleflex*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). "

Here, the mere statement that this would have been obvious to combine in order to eliminate the need for specialized knowledge simply recognizes the

problem that has been presented and solved by the present specification. There is no disclosure of reasons why these references would be combined, and every reason, given above, of why they wouldn't be combined.

Therefore, for these reasons, the patent office has not met their burden of providing a prima facie showing of unpatentability. In fact, a person having ordinary skill in the art would not make this hypothetical combination, since the teaching to make the combination comes from the present application, not from the prior art. The patent office has improperly used hindsight in picking and choosing from the references.

Hence, claim 8 should be allowable along with the claims that depend therefrom.

Claim 6, for example, states that the information automatically recognizes phrases that include the word bid, and automatically takes anaction to a bid on one of the items for sale. The patent office states that Fisher implies that the information determining part automatically recognizes the word 'bid'.

Applicant respectfully suggests that this is incorrect. The portion of Fisher referred to is describing the context of replying to an outbid message. Fisher explains column 8 lines 24-28 that the bidders can reply to this outbid message with a new bid amount. However, since these bidders are replying to an out bid message, it is clear to the system that this is a bid. This is even stated in Fisher

column 8 lines 27-29 who states that "an electronic mail bid 22 sent in reply to the

notification is received by the electronic auction system and processed by bid

validator 21 as described above". The bid validator, see for example column 7

lines 50-65 requires a specific form. That is, nothing in this prior art recognizes

the word "bid" in an e-mail, as claimed.

Moreover, claims like claim 6 that define bidding on an item make a

hypothetical combination of Fisher in view of Powell even less plausible. If one is

bidding on an item, it makes no sense to use the teaching in Powell, which teaches

modifying the webpage. 11 bids on an item, one is not modifying the webpage, in

fact bidding on an item teaches away from modifying and a webpage. Anyone who

was ever bid on an item realizes that if you modify the webpage modify which

were bidding on. It makes no sense to think that you could bid on an item on a

webpage, by modifying the webpage. If you modify the webpage, it changes what

you're bidding on. For these reasons, claim 6 is even further distinguished over

the prior art.

Claim 9 specifies that the information determining part sends messages that

include a session identifier that is a unique value that represents an item in the

auction. The rejection states that this is inherently shown in Fisher's disclosure

column 6 lines 46 to 57. Applicant believes that Fisher is actually silent on the

session ID as claimed. Fisher column 8 beginning at line 27 describes that the e-

mail bid is "processed by bid validator 21" and bid validator 21 is described column 7 lines 50-55 as processing information based on the bid form 20. Therefore, it is clear from Fisher's disclosure that Fisher uses his bid form 20 for this purpose, rather than using a session ID. For these reasons, the hypothetical combination of Fisher in view of Powell would use Fisher's teaching of validating the bid form, rather than a session ID of the type claimed.

However, claim 13 is even more specific and should be additionally allowable on its own merits. Claim 13 defines the session ID being included as part of a return address in the e-mail message. Fisher clearly states that this is not the way it works. Column 6 line 50 of Fisher states that the notification messages contains "the relevant merchandise information, the current high bid, bid increment etc.". Column 8 describes in more detail about how this is done, and describes that this bid is validated by the bid validator 21 of figure 4. Column 7 beginning at line 50 describes the bid validator examines the bid form 20. Clearly, therefore, the information in this e-mail is in the form of the bid form. Clearly, Fisher in view of Powell would use Fisher's teaching of processing the information in the form of the bid form;, not, as claimed in claim 13, "included as part of a return address in the e-mail message".

Therefore, claim 13 should be additionally allowable for these reasons.

Claim 22 defines a server that receives an e-mail message with instructions to interact, uses a keyword recognition system to automatically recognize one word to desire determine automatically the desired action of the e-mail and where that one word instructs to bid on an item. As described above:

-The patent office has improperly used applicants specification as a guide through the maze of prior art. There is no disclosure in the prior art of this combination. The only disclosure is in the present invention. This combination is made based on hindsight.

-The references could not be combined without contradicting the teaching in one reference or the other, and therefore the combination is improper.

-The reasons given for combining the references: that one would have been motivated to combine them in order to "eliminate the need for specialized knowledge in the Web" does not provide a specific reason for combining the references, but rather is a conclusory statement and does not satisfy the patent office's requirement of providing a reasoned basis for combining the references.

Claim 22 requires that the keyword recognition system instructs bidding on an item. Therefore, even if the hypothetical combination of Fisher in view of Powell were made, it would use an Fisher type auction system with Powell's teaching that e-mails could be sent to change the webpage. There is no disclosure in this combination that e-mails could be sent to bid on an item. In fact, bidding on an item is materially different than, and in essence mutually exclusive from changing a webpage, since when one bids on the item on the webpage, it makes no sense to change the webpage on which you were bidding.

Therefore, the hypothetical combination of Fisher in view of Powell does not teach or suggest the subject matter of claim 22.

Claim 25 should be additionally allowable, as nothing in the prior art teaches a session ID indicative of an individual auction on the webpage. As described above, there is no teaching or suggestion of a unique value that unambiguously represents one of the individual auctions. The bid validator 21, as described above, reviews information on Fisher's e-mail message (as it would be used in Fisher in view of Powell). There is no description of a unique value of this type in the hypothetical Fisher/Powell combination.

Claim 26 should be additionally allowable for reasons discussed above with respect to claim 6.

Claim 30 should be additionally allowable, as it specifies the session ID is part of a return address for the e-mail. Even assuming that one could interpret what is done by Fisher as being a session ID, it is certainly not part of the return address. See the discussion above.

Claim 65 specifies that the information determining part has a keyword recognition system that automatically recognizes the word "bid". As described above, Fisher in view of Powell would not be operatively combined by one having ordinary skill in the art, and the patent office has not provided any description of why this would be operatively combined.

Even if combined, the teachings of Powell, that a webpage should be modified by his instructions, would need to be contradicted in order to meet the limitations of claim 65. If one is placing a bid on an item, one cannot be modifying the webpage showing the item itself. Since Powell teaches using his system to modify a webpage, this teaching would have to be contradicted in order to place a bid on the item that is on the webpage. Therefore, claim 65 should be additionally allowable for these reasons.

Claim 67 defines that the session identification is part of the return address. This should be allowable for reasons discussed above.

Claims 3, 4, and 68 stand rejected under 35 USC 103(a) as being unpatentable over Fisher et al. (US 5,835,896) in view of Powell (US 7,058,582) and further in view of Official Notice.

These claims should be allowable by virtue of their dependency.

The current specification did admit that cell phones were known to send and receive e-mail. However, applicant traverses the official notice to the extent that it is attempting to establish that cell phones could be used to send or receive bid messages of the type claimed.

For claim 68, the official notice is respectfully traversed to the extent that it is stating that there is an alphanumeric session identification indicator in alphanumeric information in the prior art.

Claim 5 stand rejected under 35 USC 103(a) as being unpatentable over Fisher et al. (US 5,835,896) in view of Powell (US 7,058,582) and further in view of Feinberg (US 6,366,891).

This claim should be allowable by virtue of its dependency. Claim 5 specifies that userid and password are sent as part of e-mail messages of the type discussed above. The tertiary reference to Feinberg, even assuming it could be combined with the hypothetical Fisher/Powell combination, would only define a username and password must be submitted with this. It teaches nothing about doing this over e-mail in the specific way disclosed. Therefore, claim 5 should be additionally allowable for these reasons.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance. A formal notice of allowance is hence respectfully requested.

If the Examiner believes that communications such as a telephone interview or email would facilitate disposal of this case, the undersigned respectfully

encourages the Examiner to contact the undersigned.

Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail (using the email address harris@schiplaw.com). I understand that a copy of these communications will be made of record in the application file.

Please charge any fees due in connection with this response, (excluding those concurrently paid via EFS), to Deposit Account No. 50-1387.

Respectfully submitted,

Date: _6/25/2010__

_/Scott C Harris/___
Scott C. Harris
Reg. No. 32,030

Customer No. 23844
Scott C. Harris, Esq.
P.O. Box 927649
San Diego, CA 92192
Telephone: (619) 823-7778
Facsimile: (858) 678-5082